

REMARKS

The applicants respond as follows to each of the substantive paragraphs of the Office Action mailed on 8 April 2003.

Claims 172-177 are pending, and new claims 178-272 are added herein to further 5 define various aspects of the invention. The independent claims involve, *inter alia*, analyzing at least the purpose of a primary transaction to determine an upsell item to offer to a user participating in the primary transaction. The title of the instant case is amended to reflect this feature recited in the claims herein.

Paragraph 2 objected to claims 172-177 because of an informality appearing in 10 claim 172. In response, the applicants have deleted the indicated language from claim 172 as suggested by the Examiner, and accordingly request reconsideration and withdrawal of the objection lodged against claims 172-177. The subject matter cancelled from the preamble of this claim is inserted in new claims 217-219.

Paragraph 3 rejected claims 172-177 under the judicially-created doctrine of 15 obviousness-type double patenting over claims 1-267 of U.S. Patent No. 6,055,513. In response, the applicants resubmit the terminal disclaimer filed as Paper #8 on 30 September 2002. The applicants request consideration and entry of this terminal disclaimer, and request withdrawal of the double patenting rejection of claims 172-177.

Paragraph 4 rejected claims 172-177 as being unpatentable over Walker '458 20 (hereafter "Walker") in view of Kenney. In response, the applicants submit several independent arguments that this rejection should be reconsidered and withdrawn.

Firstly, the applicants submit that Walker and Kenney fail to teach or suggest: 25 "obtaining primary transaction data ... including ... *the purpose of the primary transaction*", as recited in the second sub-paragraph of claim 172, or

"utilizing at least in part the primary transaction data including *the purpose of the primary transaction*...", as recited in the fourth sub-paragraph of claim 172. Walker discloses in column 2, line 59-60 that "The offered product is determined from previous purchases that are recorded

on the billing statement ...”. In column 4, line 55 through column 5, line 7 and in column 7, lines 31 through 44, Walker provides further examples of “upsell offer conditions”, which appear to be various criteria that the Walker system examines to determine an upsell offer. These examples include purchases of predefined products, 5 purchases for more than a predefined price, purchases within a predefined price range, a predefined number of purchases having been made, purchases made at a merchant other than a predefined merchant, whether a given merchant has or has not been visited by an account holder, or combinations thereof. However, these various examples of “upsell offer conditions” fail to suggest or disclose considering the purposes for which the 10 account holder conducted the various transactions appearing on the billing statement, and then using those purposes to determine an upsell transaction to offer on the billing statement, as recited in the language quoted above from claim 12. The applicants further submit that Kenney fails to provide the teaching missing from Walker necessary to meet the applicants’ claims. Therefore, on at least this basis, the applicants respectfully submit 15 that the § 103 rejection of claims 172-177 based on Walker and Kenney should be reconsidered and withdrawn because the cited art fails to meet every feature recited in the rejected claims. These particular comments are equally applicable to new independent claims 220, 229, 240, 245, 250, 257, and 270 as added in this amendment, all of which recite the feature “obtaining primary transaction data … including … *the purpose of the* 20 *primary transaction*”, or a variation thereof.

Secondly, as to pending claim 172 and new claims 264-269, and 272, the applicants respectfully submit that Walker fails to disclose or suggest:

“offering the item to the prospective customer *in lieu of the first good or service*”,
as recited in the fifth sub-paragraph of claim 172. In contrast to the above feature,
25 Walker fully contemplates that a base transaction for first goods or services was
consummated, rather than being supplanted in favor of a second transaction, as recited in
the language quoted above from claim 172. Walker uses the actual credit card charge
data resulting from the consummated base transaction to determine a possible upsell, as
shown by Walker’s examples of “upsell offer conditions” discussed above. In the Walker
30 system, the only reason this charge data exists is because the base transaction has already

been consummated when the potential upsell transactions to be printed on the billing statement are determined. Examples of upsells offered by Walker's system include incentives or discounts towards a future purchase, e.g. a "discounts on predetermined products" (Walker, column 2, line 11), or on a companion product, e.g., "products complementary to previously purchase [sic] products" (Walker, column 2, line 12-13).
5 However, none of these examples disclose or suggest upsell items that are offered in lieu of the primary or base transaction, as recited by the above excerpt from claim 172. The applicants respectfully submit that Walker teaches away from the applicants' claimed invention because Walker contemplates offering upsell transactions to the account holder
10 well after that holder has completed one or more primary transactions, rather than offering the holder an upsell transaction in lieu of the primary transaction. Further, the applicants respectfully submit that Kenney fails to provide the teaching missing from Walker. On at least this basis, the applicants respectfully submit that the § 103 rejection
15 of claims 172-177 based on Walker and Kenney should be reconsidered and withdrawn because the cited art fails to meet every feature recited in the rejected claims, and in fact teaches away from the claimed subject matter. These particular comments are equally applicable to new dependent claims 264-269 added in this amendment.

Thirdly, the applicants have added several new claims further to define various aspects of the invention, including new dependent claim 195 depending from claim 172,
20 which recites that the upsell item is offered to the prospective customer in real time with the primary transaction. As discussed above, Walker contemplates that the upsell is generated and offered to the account holder via the account statement well after completion of the base transaction. Depending on the timing of the base transaction relative to account billing cycles, the upsell item could be offered to the account holder as
25 many as thirty days after the primary transaction, or more. As Walker states: "During that period of time, the account holder may have reconsidered those purchases and realized that a complementary product should have been purchased as well." (Walker, column 3, lines 4-9). Further, Walker does not provide means for communicating with the account holder at the time that the account holder is conducting the primary
30 transaction. The applicants respectfully submit that Walker, read fairly as a whole, does not contemplate a real time system, as recited in dependent claim 195, and in fact

expressly teaches away from such a real time system. These comments are equally applicable to new dependent claims 228, 239, 244, 249, 256, 263, and 271 added in this amendment.

In making the above arguments to expedite the prosecution of this application, the
5 applicants do not concede that Walker is properly combined with Kenney under § 103,
but instead reserve the right to submit comments in the future arguing that Walker and
Kenney are not properly combined under § 103.

The applicants submit that the subject matter recited in all new claims added
herein is fully supported by the originally-filed specification. The applicants will gladly
10 provide citations to such specification at the Office's request.

Favorable action is requested at the Office's earliest convenience. If discussion of
this application would expedite matters, the Office is requested to contact the
undersigned at the telephone number listed below.

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Respectfully submitted,

Dated: 8 JULY 03

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